

REMARKS

By this Amendment, claims 27, 28, 33, 36-38, 40, 41, 67, 68, 72, 73, 75-77, 79, and 80 have been canceled, without prejudice or disclaimer and reserving the right to re-present the subject matter of any of those claims in this application or another application claiming priority to this application. In addition, claims 1-26, 29-32, 34, 35, 39, 42-66, 69-71, 74, and 78 have been amended, and claims 81-84 are added. Consequently, claims 1-26, 29-32, 34, 35, 39, 42-66, 69-71, 74, 78, and 81-84 are pending in this application, with claims 1 and 42 being independent. Of those pending claims, claims 4-6, 12-14, 16, 18, 20, 25, 35, 44-46, 52-54, 56, 58, 60, and 65 have been withdrawn from consideration as being allegedly drawn to a non-elected species.

For the reasons explained below, Applicant respectfully requests that the Examiner reconsider the present application and withdraw all of the outstanding claim rejections.

In the Office Action, claims 1-3, 7, 8, 15, 17, 22-24, 26, 27, 31-33, 39-43, 47-49, 55, 57, 62-64, 66, 67, 71-73, and 78-80 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Utility Model Laid-Open Publication No. 62-114781 to Mitsubishi Pencil Co. ("Mitsubishi Pencil"). Office Action at 2 and 3. In addition, claims 9-11, 19, 21, 28-30, 34, 36, 37, 38, 49-51, 59, 61, 68-70, and 74-77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsubishi Pencil alone or in combination with one of the following secondary references: European Application Publication No. 0651955 ("EP '955"); U.S. Patent No. 3,393,962 to Andrews ("Andrews"); and U.S. Patent No. 4,403,624 to Montgomery ("Montgomery"). Office Action at 4-6.

Although Applicant does not necessarily agree with these rejections, Applicant has amended each of independent claims 1 and 42 to further patentably distinguish the claimed subject matter from the cited references. More specifically, each of independent claims 1 and 42, as amended, is now directed to a “device for applying a product to nails.” The device includes, among other things, “a receptacle containing a nail product, and an applicator for applying the nail product to the nails.” The claims also each recite that “the applicator includes a stem, the applicator elements being secured in a housing at an end portion of the stem, the housing presenting a shape that diverges towards the outside so that the applicator elements form a broader bundle.” As explained below, Mitsubishi Pencil and the cited secondary references, taken either alone or in combination, do not teach or suggest the subject matter of claims 1 and 42.

For example, Mitsubishi Pencil does not teach or suggest, among other things, the recited “housing presenting a shape that diverges towards the outside so that the applicator elements form a broader bundle” of claims 1 and 42. While Mitsubishi Pencil is silent as to the shape of any housing holding fibers of its writing core, it teaches that the writing core 1 is formed such that a great number of the fibers are bundled and their tips are made sharp. See page 1 of the English language translation of Mitsubishi Pencil submitted in a Supplemental Information Disclosure Statement filed April 19, 2007. Since the writing instrument of Mitsubishi Pencil requires a sharp tip, the housing that holds fibers of Mitsubishi Pencil's writing core would not likely have “a shape that diverges towards the outside so that the applicator elements form a broader bundle,” as recited in claims 1 and 42. Moreover, since having a sharp tip is one of the main characteristics of Mitsubishi Pencil, one of ordinary skill in the art would not have

modified the writing instrument of Mitsubishi Pencil to have “a housing that diverges towards the outside,” regardless of any purported teaching of a secondary reference. Therefore, independent claims 1 and 42 further patentably distinguish from Mitsubishi Pencil and the cited secondary references.

In addition, Mitsubishi Pencil does not teach or suggest, among other things, “a device for applying a product to nails [comprising] a receptacle containing a nail product,” as recited in independent claims 1 and 42. Instead, Mitsubishi Pencil discloses a writing core of a writing instrument. Also, there is absolutely no teaching or suggestion that the writing instrument of Mitsubishi Pencil would be used to apply a product to nails.

Worth noting is that, in the rejection of now-canceled claims 36, 37, 75, and 76, the Examiner asserted that “[i]t would have been obvious ... to provide a receptacle containing the nail product or eyelash/eyebrow product with the [Mitsubishi Pencil] applicator when the applicator were used [*sic*] for nail or eyelash/eyebrow application by a user.” Office Action at 5. This allegation, however, appears to be premised upon an unsupportable mischaracterization that Mitsubishi Pencil discloses an applicator for applying a cosmetic product. As discussed above, however, Mitsubishi Pencil does not disclose an applicator for applying a cosmetic product. To the contrary, it discloses a writing core of a writing instrument, and there is no teaching or suggestion for using its writing instrument for applying a nail product or any other cosmetic product. Thus, the Examiner’s allegation that one of ordinary skill in the art would provide a receptacle containing a nail product or eyelash/eyebrow product “*when the [writing instrument is] used for nail or eyelash/eyebrow application by a user*” is not only unfounded in the

teachings of Mitsubishi Pencil but also an improper, impermissible hindsight reasoning. Absent an express teaching that the writing instrument of Mitsubishi Pencil were to be used for applying a cosmetic product, it would be illogical and senseless to assert that one of ordinary skill in the art would have provided a receptacle containing a nail product with the writing instrument of Mitsubishi Pencil.

For at least the reasons set forth above, claims 1 and 42, and their respective dependent claims, define novel and non-obvious subject matter over Mitsubishi Pencil and the cited secondary references.

Conclusions

In view of the foregoing reasons, Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding rejections, and timely allowance of all pending claims.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

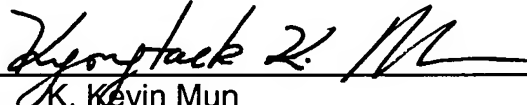
If a telephone conversation might advance prosecution of this application, the Examiner is invited to call the undersigned representative at (571) 203-2700.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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